

REMARKS – General

By the above amendment, Applicant has amended the title to emphasize the novelty of the invention.

As per the discussion in interview with Examiner Naeem Haq and Examiner Yogesh, Applicant has rewritten all claims to define the invention more particularly and distinctly so as to define the invention patentability over the prior art. Following are the changes and specific references from specifications:

1. Added limitation of use of computerized system in performing the methods.

Reference in specifications: System Components and primary functions – page 11, line 7-23, page 12 lines 1-20.

2. Added limitation of trade action data storage and maintenance for plurality of on-line transactions across plurality of independent marketplaces.

Reference in specifications: User Action Database – page 7, line 13; Processing and storage of user actions – page 12, lines 17-20, Figure 4C; Recording of user trade actions plurality of on-line transactions across plurality of independent marketplaces – page 4, lines 20-23, page 5, lines 3-6; Method description and operation – page 14, lines 3-21, page 18, lines 14-24, page 19 lines 1-7; Advantage – page 23, lines 17-20, page 24, lines 12-15.

3. Added limitation of rating analysis by utilizing uniform criteria.

Reference in specifications: Rating analysis using uniform criteria – page 3 lines 5-9, page 5 lines 3-4, page 23 lines 12-15, page 24 lines 3-4; Operation – page 19 lines 17-25, page 20, page 21, lines 1-19.

4. Added limitation of disclosing rating analysis.

Reference in specifications: Disclosing rating analysis – page 15 lines 1-12; Operation – page 19 lines 17-23, page 20 lines 15-19, page 21 lines 20-26, page 22 lines 1-5.

Also, as discussed in the interview, the limitations of the feedback method are specified in the application in section for description of prior art (page 3, lines 5-9). Present invention teaches a novel and unobvious method that removes this limitation.

Arguments:

Reference on Dutta is ineffective

Reference cited in the last office action on Dutta (Date Filed: 12/07/2000) is ineffective because Applicant has an earlier filing date due to my Provisional Patent Application (PPA) – Application Number: 60/215,526, Filing Date: 06/30/2000.

Rejection Of Claim 1 And 2 On Rackson And Ng Is Overcome

The last Office Action rejected independent claims 1 and 2 based on cited prior art by Rackson and Ng. Claims 1 and 2 are rewritten as claims 3 and 4 respectively to define patentability over these references, and any combination thereof. Applicant requests reconsideration of this rejection, as now applicable to claims 1 and 2 for the following reasons:

- (1) There is no justification, in Rackson and Ng, or in any other prior art separate from applicants' disclosure, which suggests that these references be combined, much less be combined in the manner proposed.

- (2) There is lack of logical link in methods suggested by Rackson and Ng
- (3) Even if Rackson and Ng were to be combined in the manner suggested, the combination would not show all the features of claims 3 and 4.
- (4) The novel physical features of claims 3 and 4 produce new and unexpected results and hence are unobvious and patentable over these references.
- (5) Claim 3 and 4 show a completely new principle of operation compared to Rackson, Ng or any combination thereof

The References and Differences of Present Invention Thereover

Prior to discussing the claims and the argument points, applicant will first discuss the cited references and the general novelty of the present invention and its unobviousness over the references.

Rackson teaches a multi-auction service that receives details for the item to be auctioned and bidding parameters from the submitter and co-ordinates with multiple remote auction services to replicate the auction details and bids received to achieve the optimal bid (column 6, lines 44-63).

Rackson records the trade action details across multiple remote auction services; however he does not analyze or correlate these transactions as has been aptly noted in the last office action (column 7, lines 7-35).

Purpose of Rackson's recording of the trade action data is to select an optimal bid and to replicate it across multiple remote auction services. Rackson does not teach to assess the

credibility of the trade and the participants by analyzing their trade action patterns (column 6, lines 44-63; column 7, lines 18-36).

Method taught by Rackson cannot be used to determine credibility of the participants as can applicant's method.

Ng teaches a searchable price/product database available over the World Wide Web to allow users to search for a product supplied by multiple online or offline stores and refer to the details of the product available with the store (column 3 lines 23-40).

Ng in her invention refers to assessing the seller's integrity by recording the feedback from the purchasers about the seller. However, Ng does not teach analysis of trade actions in order to determine integrity of the participant. Neither does Ng teach method for creating a uniform platform for rating the participants (column 2, lines 27-30).

Ng's approach of assessing the seller's integrity by recording the feedback from the purchasers has serious limitations. The feedback is subjective to buyer's personal comments about the seller and the trade. The facts are not verifiable as they are in the method proposed by the present invention, analyzing the trade actions that are verified by the participating marketplace. Applicant discusses the limitations of the feedback method in the application in section for description of prior art (page 3, lines 5-9).

Another disadvantage that Ng's method has is that the sellers themselves can easily manipulate the feedback. The completely new method in the present invention obviates this

drawback since trade action history is based on actual trades reported by the electronic marketplaces and cannot be manipulated.

Article by Mannix in US News & World Report, Sept. 27 1999, cited as reference, also refers to method utilized by Amazon, Inc to assess integrity of the seller by soliciting feedback from the buyers (lines 1-8). This method is same as by Ng and has same limitations as explained earlier.

Furthermore, in the article author clearly notes the disadvantage of the “feedback” method (lines 9-16) as follows:

“ But does the feedback help buyers determine whether sellers are reputable? “I think it’s really hard to evaluate that information,” says Susan Grant, director of the National Fraud Information Center in Washington, D.C. “It hasn’t been screened by anyone, and no one has investigated the complaint.”

The system can be manipulated. Anyone can post a positive comment in feedback. And dome are afraid to post negative remarks, fearing retaliatory negative grade.”

The method that the present invention teaches removes these drawbacks and offers a resulting rating system that is far superior to the “feedback” method.

With regard to utilizing analysis & correlation technique for trade action history across multiple electronic marketplaces to determine credibility of the trade and participants,

applicant teaches this for the first time. As stated, since this procedure was not done before, neither it nor its concomitant advantages were known or appreciated.

Argument Details

(1) There is no justification, in Rackson and Ng, or in any other prior art separate from applicants' disclosure, which suggests that these references be combined, much less be combined in the manner proposed

With regard to the proposed combination of Rackson and Ng, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art references themselves to be validly combined for use in a prior-art § 103 rejection, *the references themselves* (or some other prior-art) must suggests that they be combined. E.g., as was stated in In re Sernaker, 217 U.S.T.Q. 1, 6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment co. v. United States, 217 U.S.P.Q. 193,199 (CAFC 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right reference in the right way to achieve the results of the claims in suit [here the claims pending]. Monday morning

quarterbacking is quite improper when resolving the question of non-obviousness in the court of law [here the P.T.O.]”

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (CC.A.F.C. 1988), “[w]here prior-art references require selective combination by court to render obvious subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself....*Something in the prior-art must suggest the desirability and thus the obviousness of making the combination.*” [Emphasis supplied.]

In line with these decisions, recently the board stated in Ex parte Levengood, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present the evidence, preferably in form of some teaching, suggestion, incentive or inference in the applied prior-art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and / or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing quotes have often advised the Patent and Trademark Office that it can

satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objecting teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that ‘would lead’ that individual ‘to combine the relevant teachings of the references.’ ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.”

In the present case, there is no clear reason given in the last office action to support the proposed combination, other than the statement “However, Ng teaches this limitation (column 2, lines 27-30)” (p. 2). However, Ng refers to the method of assessing credentials uses “feedback” method and is completely different than that of present invention, which uses the correlation of trade action history. Rackson records the trade related actions but does not make any reference or suggestion to analyze and correlate the trade actions to determine credentials of the participant and credibility of the transaction as appropriately noted in the office action “ Rackson does not teach correlating, and analyzing recorded trade actions, and transaction patterns across multiple independent electronic marketplaces to create credibility ratings, whereby said credibility ratings will aid in decision making process by disclosing true intention of participants to make a successful online transaction based on earlier captured trade actions.” (p. 2)

The purpose of Rackson’s invention is to reach optimal bid for an item being auctioned by coordinating and conducting the auction simultaneously at multiple remote auctions, while purpose of Ng’s invention is to make relative price/product information available to users with a reward system for giving incentives for utilizing or correcting the information.

Additionally, Ng makes no reference of extending or utilizing Rackson's method in any way. Both the prior-art references neither express nor imply any suggestion that they be combined in the manner suggested in the office action. Limitation suggested in the office action is not applicable to Rackson's method of recording trade actions across multiple electronic marketplaces because Ng's reference to seller's integrity is by using the process of purchaser's feedback and does not suggest use of trade action history. Both inventions from Rackson and Ng are complete and functional in themselves; so there would be no reason to use parts from or add or substitute parts to any reference.

Applicant therefore submits that combining Rackson and Ng is not legally justified and is therefore improper. Thus they submit that the rejection on these references is also improper and should be withdrawn.

Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner include an explanation in accordance with M.P.E.P. § 706.02, Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985) and Ex parte Levengood, supra, a "factual basis to support his conclusion that it would have been obvious" to make the combination.

(2) There is lack of logical link in methods suggested by Rackson and Ng.

Furthermore, the method that Rackson teaches to record the trade actions (column 9, lines 33-35) and the reference that Ng makes to assess seller's credentials by buyer's feedback (column 2, lines 27-30) cannot be combined as there is no direct logical link between recorded trade actions and recorded feedback to arrive at assessing the credentials of the

seller. Just recoding the feedback as suggested by Ng would be sufficient to assess the credentials of the seller by the method suggested by Ng. There will be no need for Ng to record the trade actions as suggested by Rackson to complete seller's credential assessment based on buyer's feedback. The method suggested by Applicant's invention is completely different than Ng and does not utilize feedback.

(3) Even if Rackson and Ng were to be combined in the manner suggested, the combination would not show all the features of claims 3 and 4. Present invention teaches new principle of operation compared to Rackson, Ng or any combination thereof.

However, even if the combination of Rackson and Ng were legally justified, claims 3 and 4 would still have novel (and unobvious) physical features over the proposed combination. In other words, applicant's invention as defined by claims 3 and 4, comprises much more than merely substituting a plurality of templates for one template.

Rackson teaches a system and method that includes as a step of the process detecting bids at remote auction services using identification data for the sellers and bidders. As appropriately noted in the office action, the features of Rackson's invention do not include utilization of trade action data to analyze trade actions correlating the history and trend to forecast credibility of user trade actions.

Rackson suggests recording the trade actions across multiple electronic marketplaces for reaching optimal bid in an auction. The present invention comprises of the initial step of recording trade actions also. However, utilization of the data by the proposed invention is completely different than that of Rackson's invention.

Ng in her invention refers to assessing the seller's integrity by recording the feedback from the purchasers about the seller. The present invention's primary feature is to analyze trade actions of a user transparently across independent marketplaces to rate credibility in a uniform fashion. Ng does not teach analysis of trade actions in order to determine integrity of the participant. Nor does Ng teach method for creating a uniform platform for rating the participants.

The method includes distinct feature that neither Rackson nor Ng teach for correlating the trade action analysis creating a uniform rating platform. Thus applicant submits that their invention is much more than merely substituting a plurality of templates for one template and that claims 3 and 4 clearly recite novel physical subject matter, which distinguishes over any possible combination of Rackson and Ng.

(4) The novel physical features of claims 3 and 4 produce new and unexpected results and hence are unobvious and patentable over the prior-art references under § 103.

Also applicant submits that the novel physical features of claims 3 and 4 are unobvious and hence patentable under § 103 since they produce new and unexpected results over Rackson and Ng, or any combination thereof.

Ng as well as article by Mannix in US News & World Report, Sept. 27 1999 refers to using feedback as a method to determine integrity of the seller. However, this method has serious limitations due to subjective nature of the feedback method and undue influence on the

ratings due to personality changes or even subjectivity to manipulation by the participants themselves.

In the article Mannix clearly notes the disadvantage of the “feedback” method (lines 9-16) as follows:

“ But does the feedback help buyers determine whether sellers are reputable? “I think it’s really hard to evaluate that information,” says Susan Grant, director of the National Fraud Information Center in Washington, D.C. “It hasn’t been screened by anyone, and no one has investigated the complaint.”

The system can be manipulated. Anyone can post a positive comment in feedback. And some are afraid to post negative remarks, fearing retaliatory negative grade.”

The method that the present invention teaches removes these drawbacks and offers a resulting rating system that is far superior to the “feedback” method.

Also Ng’s reference is primarily limited to purchaser’s feedback on seller and does not express or imply creating credibility rating for all the participants in a uniform way as aptly noted in the office action “The cited prior art does not teach whereby said credibility ratings will provide uniform ratings by capturing specific set of data across multiple independent exchanges and tracking uniform transaction patterns.” (p. 3) The claim is appropriately modified to claim this feature as noted by the office action.

These new and unexpected results are also the ability of the applicant's system to create credibility ratings by utilizing uniform criteria across multiple electronic marketplaces and across multiple participants to perform unbiased assessment. This in turn results in a monitoring facility across multiple independent exchanges to disclose true intentions of participants to make a successful trade. Applicant's system therefore is vastly superior to that of either Rackson or Ng, or any possible combination thereof. The novel features of applicant's system that effect into these differences are, as stated, clearly recited in claims 3 and 4.

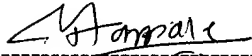
Conclusion:

For all of the above reasons, Applicant submits that the specifications and claims are now in proper form, and that the claims all define patentability over the prior art. Therefore, applicant submits that this application is now in condition for allowance, which action they respectfully solicit.

Conditional request for Constructive Assistance:

Applicant has amended the claims of the application so that they are in proper, definite, and define novel structure, which is unobvious. If, for any reason this application is believed not to be in full condition for allowance, applicant respectfully requests constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. 2173.02 and 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,



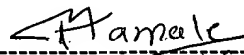
Mahesh Harpale

13 Crefeld Ct,

Lincoln Park, NJ-07035

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October 18, 2004



Mahesh Harpale, Applicant